

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

International Application No.: PCT/DE95/00055
International Filing Date: 16 January 1995
Application No.: 08/676,355
Filing Date: 19 July 1996
Inventors: Gerhaeuser et al.
For: Method of Determining the Receptivity
of Wireless Signals in a Broadcast System

86 Sparks Street
Cambridge, MA 02138-2216
29 July 1998

Hon.
Assistant Commissioner for Patents
Box PCT
Washington, DC 20231

Attention: PCT Legal Office

Renewed Petition Pursuant to 37 C.F.R. 1.137(a)

Sir:

By a Decision on Petition dated 9 March 1998, Applicants' prior petition pursuant to 37 C.F.R. 1.137(a) dated 2 October 1997 and acknowledged to have been received by the Patent & Trademark Office on 6 October 1998 was dismissed without prejudice.

Having submitted under separate cover on even date herewith a Petition pursuant to 37 C.F.R. 1.136(a) for a three (3) months' extension for response to the said Decision on Petition, Applicants are filing this renewed petition in an earnest attempt to revive the instant unavoidably abandoned application. They have noted with appreciation that no additional petition fee

is required.

Showing of the Cause of Unavoidable Delay

The instant application for commencing the U.S. National Phase was filed in the Patent & Trademark Office on 19 July 1996 *without Applicants' Declaration.*

A duly executed declaration was sent by Applicants' Attorney to the Patent & Trademark Office (PTO) under a cover letter (copy enclosed) with a Certificate of Mailing pursuant to 37 C.F.R. 1.8 on 30 July 1996, together with assignee Fraunhofer's Certificate of Small Entity Status, Applicants' assignment and a Recordation Cover Sheet, the Attorney's check No. 3429 dated 30 July 1996 for \$105.00 to cover the fees under 37 C.F.R. 1.16(e) and 1.21(h), a Request for Refund of Excessive Fee Paid, as well as a Post Card Receipt. While except for the Attorney's docket number 960160 the Post Card Receipt did not identify the application number to which these documents pertained, their Attorney's cover letter, the Small Entity Certificate, Certificate of Mailing, and the (now canceled) check did identify Application No. 08/676,355. *The Declaration and Power of Attorney did not identify the PTO-assigned Application number because of the prohibition against alterations set forth in sections 602.01 and 605.05(a) of the Manual of Patent Examination Procedure. It did, however, identify both the numbers (P 44 01 460.0) of the German priority application and of its corresponding International Application (PCT/DE95/00055) so that the presumably expert PTO personnel should have had no difficulties matching the Declaration with the PTO application file.*

These documents were acknowledged to have been received by the PTO on 20 August 1996 by the post card receipt referred to, and to Applicants the Post Card was a clear and unambiguous confirmation of the Patent Office having received those documents, including the duly executed declaration, and that the application would henceforth proceed in the normal

fashion.

However, on or about 17 September 1996 Applicants' Attorney received a Notice of Missing Requirements..., Form PCT/DO/EO/905, mailed 4 September 1996, to which a response dated 17 September 1996 was immediately filed with the PTO. Included in that response were copies of all of the previously submitted documents.

Not until about 29 April 1997 did Miss Vonda Wallace, the person who signed the above-mentioned Notification of Missing Requirements, telephone Applicants' Attorney advising him that the originally filed documents had been lost by the PTO and requesting copies thereof together with a petition under 37 C.F.R. 1.181. These were submitted with a paper which erroneously but without deceptive intent was dated 17 September 1996. However, the accompanying First Class Mailing Certificate was correctly dated 29 April 1997. These documents were acknowledged to have been received by the PTO on 5 May 1997.

It is respectfully submitted that the present proceedings are the unavoidable consequence of the loss by the PTO of the originally submitted documents, including the declaration. But for this loss, the copies of the declarations since sent to the PTO merely as evidence that a properly executed declaration had previously been submitted, would not have been necessary. Those copies did not, and were not intended to, comply with statutory and regulatory requirements.

While the postcard for lack of the application number thereon may not, by itself, be sufficient to establish that a properly executed declaration had been filed with and received by, the PTO, it is Applicants' considered opinion that their Attorney's canceled check No. 3429 (copy enclosed) does in fact prove that such a declaration was received by the PTO. For that check does identify the application by number and is identified in the Attorney's cover letter of 30 July 1996 to the PTO which also shows the application number.

Surely, Applicants cannot be held responsible for, nor can they control, the manner in which documents are handled by the PTO. That would constitute a burden to which, in the words of the late U.S. Supreme Court Justice Cardozo, "equity will not lend the hand of healing benediction".

It is respectfully submitted that the general public is entitled to rely upon the PTO handling documents entrusted to it with care and that in those exceptional cases, as the present one, where such documents have been lost by the PTO, without Applicants being in any position to exercise any control over the actions of the PTO, the PTO does not shun its responsibility because of a post card receipt which in the opinion of the PTO does not name an application by its number when, as here and as set forth above, redundant other indicia were submitted to the PTO which unequivocally identified the application to which those documents pertain.

Applicants are aware of the requirements pertaining to petitions filed under 37 C.F.R. 1.137(a) and they urge, with respect, that the facts set forth above do indeed provide ample showing that because of the manner in which the documents acknowledged to have been received under date of 20 August 1996 were handled by the PTO, the abandonment of the instant application was unavoidable. Since the instant application did not become abandoned for failure to respond to an Official Action on the merits of the invention disclosed, Applicants do not know what their proposed response should be, except that they will submit a newly executed Declaration and Power of Attorney. Since the current state of abandonment of the instant application is the result of conduct by the PTO over which Applicants had no control, filing of a terminal disclaimer would appear not to be necessary.

In the circumstances herein set forth it is urged that the extension fee under 37 C.F.R. 1.17(c) submitted under separate cover is not justified and that it should be refunded.

Having regard to the Legal Examiner's allegation in the first paragraph

of page 3 of his Decision on Petition, Applicants fail to see in what manner the last name of the first named inventor does not correspond to the name set forth in the international application. The first inventor's surname is spelled, in German, "Gerhäuser" and, in English (because it has no symbols for German umlauts) "Gerhaeuser". The fact that Applicants submitted the surcharge for late filing (37 C.F.R. 1.16(e) of their declaration is evidenced by their Attorney's canceled check No. 3429.

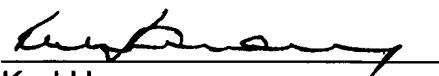
It is respectfully urged that the circumstances set forth hereinabove clearly and unequivocally show that Applicants' Attorney properly submitted those documents not available to him at the time of filing the instant application and that to hold Applicants responsible for loss of those documents by the PTO would contravene basic principles of law and equity.

Securing a new declaration from the inventors who are affiliated with different organizations is at present underway but has been made difficult as some of the inventors, having left their former employment, have not located. That declaration will be submitted to the PTO as soon as it becomes available.

In the meantime, assignee Fraunhofer is submitting a new Certificate of Small Entity Status under separate cover.

Since the facts set forth above exonerate Applicants and their Attorney of any responsibility for the loss of the properly submitted documents and the unfortunate consequences resulting therefrom, it is respectfully urged that the instant application be revived or put *in statu quo ante*, as the case may be, and that the fee submitted under 37 C.F.R. 1.17(c) be refunded.

Respectfully submitted,



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